

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10013718-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Haines

Application No.: 09/981,885

Filing Date: Oct. 17, 2001

Title: Media Imprinted With Media Parameter Information

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

Confirmation No.: 7082

Examiner: Tamra Dicus

Group Art Unit: 1774

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Feb. 10, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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OR

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (703) 305-0942 on Mar 10 2005

Respectfully submitted,

Robert Haines

By

Steven R. Ormiston

Attorney/Agent for Applicant(s)

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Date of Deposit: Mar. 10, 2005

Typed or printed name: Tamra F. Paulin

Signature: [Signature]

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Robert Haines

ATT. DOCKET NO.: 10013718-1

SERIAL NO.: 09/981,885

GROUP ART UNIT: 1774

FILED: October 17, 2001

EXAMINER: Tamra Dicus

TITLE: Media Imprinted With Media Parameter Information

APPELLANT'S/APPLICANT'S OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellant, Appellant's legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claim 1-5 and 31-40 are pending. The rejection of Claims 1-5, 31-33 and 35-40 is appealed. The rejection of Claim 34 is not appealed.

4. STATUS OF AMENDMENTS.

No amendments to the claims were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

The claims are directed to printer sheet media marked on an edge and on a face with information that may be used to configure a printer or other imaging device. Claim 1, for example, recites a sheet of print media (e.g., sheet 100 in Figs. 1 and 2), comprising:

facial portions (e.g., face 106 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6);

edge portions (e.g., edge 104 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6);

a single fluid-based marking positioned on a facial portion and on an edge portion, the edge portion covering an area that is adjacently positioned and substantially perpendicular to an area of the facial portion (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); and

wherein the single fluid-based marking comprises data for configuring an imaging device from the facial portion and/or from the edge portion (e.g., Specification, page 5, lines 15-24 and page 10, lines 4-10).

Claim 5, for example, recites a stack of print media (e.g., stack 302 in Fig. 3) comprising a plurality of sheets each being a sheet as recited in Claim 1.

Claim 32, for example, recites a sheet of print media (e.g., sheet 100 in Figs. 1 and 2) comprising:

a plurality of facial portions (e.g., face 106 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6);

a plurality of edge portions (e.g., edge 104 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6), each facial portion being adjacent and substantially perpendicular to a respective edge portion (e.g., face 106 and edge 104 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6); and

a fluid-based marking (e.g., marking 102 in Figs. 1 and 2 and Specification, page 5, line 15 through page 6, line 6) that has been imprinted on the sheet in one or more imaging actions to position the fluid-based marking on both a particular face portion and on a particular edge portion (e.g., Figs. 3 and 4 and Specification, page 6, line 7 through page 8, line 6), the particular face portion and the particular edge portion being adjacent and substantially perpendicular with respect to one another, the fluid-based marking comprising media parameters corresponding to the sheet (e.g., Specification, page 5, lines 15-24 and page 10, lines 4-10).

6. GROUNDS OF REJECTION TO BE REVIEWED.

1. A fluid-based marking that comprises data "for configuring an imaging device" is not a recitation of intended use that the Examiner may ignore when determining patentability.
2. Hoppe (4278722), which teaches a lamination process for a layered identification card, is non-analogous art. There is no suggestion or motivation in the art to combine Hoppe and Meunier (6582138).
3. The combination of Hoppe (4278722) and Meunier (6582138) does not teach or suggest all claim limitations.

7. ARGUMENT.

Claims 1-5, 31-33 and 35-40 were rejected under 35 U.S.C. § 103(a) as being obvious over Hoppe (4278722) in view of Meunier (6582138).

GROUND NO. 1

**A Fluid-Based Marking That Comprises Data For Configuring An Imaging Device
Is Not A Recitation Of Intended Use That The Examiner May Ignore When
Determining Patentability**

Ground No. 1 applies to Claims 1-5 and 31.

Claim 1 recites a fluid-based marking that comprises data for configuring an imaging device. The Examiner does not give this limitation patentable weight because, the Examiner asserts, it is a "recitation with respect to the manner in which a claimed

product is intended to be employed...." Final Office Action, page 4. This assertion is not correct.

While this limitation may be deemed to have both structural and functional elements, it is not merely a recitation of intended use. In Claim 1, the phrase "for configuring an imaging device" modifies "data." The single fluid-based marking comprises "data." What kind of data? Data for configuring an imaging device. This is no less a structural limitation simply because it suggests the fluid-based marking data will be used to configure an imaging device. To the extent "for configuring an imaging device" is deemed a functional limitation on the data, it is well settled that any such function limitation is proper and must be accorded patentable weight. See e.g., *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430, 1433 (Fed. Cir. 1990) and *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) ("members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly).

The Examiner's reliance on *Ex parte Masham*, 2 USPQ.2d 1647 (BPAI 1987) is misplaced. In *Masham*, the Board held that the recitation of the material intended to be worked on by a claimed apparatus does not impose any structural limitations which differentiate it from a prior art apparatus satisfying the structural limitations of the claim. The Board then went on to state more broadly (and quite unnecessarily) that the "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus" Even this broad language in *Masham* has never been construed as a ban on functional limitations. Rather, the holding in *Masham* is limited to statements of intended use for "a claimed apparatus." Claim 1 is directed to a sheet of print media that includes a fluid based marking – an article of manufacture. The fluid-based marking comprising data "for configuring an imaging device" is not a statement of intended use for "a claimed apparatus" or even the claimed article. Rather, it is a functional limitation that quite properly defines the data of the fluid-based marking.

The Examiner has made no showing that any of the cited references teach a fluid-based marking that comprises data for configuring an imaging device, as recited in Claim 1. Absent such a showing, the rejection of Claim 1, and Claims 2-5 and 31 depending from Claim 1, should be withdrawn.

GROUND NO. 2

There Is No Suggestion Or Motivation In The Art To Combine Hoppe And Meunier

Ground No. 2 applies to all appealed claims.

Obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). As detailed below, the Examiner has failed to make the required findings. In fact, no such evidence exists in the record.

Meunier teaches a bar code or other such marking positioned on the edge of a sheet to uniquely identify the sheet. Hoppe teaches a lamination process for a layered identification card that allows printing over the full face of the card. The two teachings are not even close – Hoppe is non-analogous art. The Examiner is obligated to show that a person of ordinary skill in the printing arts would reasonably be expected to look to card laminating techniques like those disclosed in Hoppe when faced with the problems noted in the Background section of the Specification. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992); MPEP 2141.01(a). The Federal Circuit's decision in *In re Oetiker* is on point.

"The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.... Oetiker's invention is simple. Simplicity is not inimical to patentability." *In re Oetiker*, 24 USPQ 2d at 1446.

In Hoppe, the lamination film 6 is so thin that the printed pattern on the face of the card may extend without interruption "over the film edge 7 and possibly over the subsequent identification-card edge 8." Hoppe, column 4, line 64 through column 5, line 4. It is just not reasonable to suggest someone skilled in the art of sensing information coded on print media, Jean-Luc Meunier at Xerox or Bob Haines at Hewlett-Packard for example, would look to Hoppe to advance the art. Or, on the off

chance that Mssrs. Meunier and Haines should stumble across Hoppe, that they would suddenly realize the disadvantages of Mr. Meunier's ID edge coding and that they could and should extend Meunier's edge bar code ID up on to the face of the media and add media parameters or other information for configuring a printer. The Examiner's suggestion in this regard is just not plausible. Hoppe is no more related to what Meunier and Haines have done than is any other paper lamination technique.

The Examiner asserts it would be obvious to combine Hoppe and Meunier "because Meunier provides printed ink and a barcode on a sheet or a plurality of sheets for the purpose of identifying the sheet and for use in documents such as magazines or books for identifying the plurality of sheets when used in storage and retrieval" Final Office Action, page 4. The Examiner's assertion is not evidence of motivation. Rather, it is simply a statement of the teaching of Meunier. The fact that Meunier uses barcodes printed on the edge of sheet or stack of sheets to identify the sheet(s) is not a suggestion or motivation to combine that teaching with Hoppe (or anything else).

The Examiner has failed to produce any evidence that it would have been obvious to combine Hoppe and Meunier. In fact, it would not have been obvious to combine Hoppe and Meunier.

GROUND NO. 3

The Combination Of Hoppe And Meunier Does Not Teach Or Suggest All Claim Limitations

Ground No. 3 applies to all appealed claims.

Claims 1 and 32 recite a fluid-based marking positioned on a facial portion (face portion in Claim 32) and on an edge portion. Meunier teaches a bar code or other such marking positioned on only the edge of a sheet. The Examiner asserts that Hoppe teaches a marking positioned on both a face portion and on an edge portion of a sheet. This assertion is not correct.

In Hoppe, the lamination film 6 is so thin that the printed pattern on the face of the card may extend without interruption "over the film edge 7 and possibly over the subsequent identification-card edge 8." Hoppe, column 4, line 64 through column 5, line 4. While Hoppe suggests printing "over" the edge of the card, it is clear Hoppe is not printing *on* the edge of the card as in the claimed invention. Printing "over" the

edge in Hoppe refers to printing past the edge not on the edge, as is clearly evident in the figures.

Further, the so-called identification data noted by the Examiner is actually the "identification card data" printed on the face of the card, such as might appear on the face of a driver's license. This identification card data has absolutely nothing to do with configuring the imaging device as in Claim 1 (data for configuring an imaging device) or the characteristics of the sheet on which it is printed as in Claim 32 (media parameters corresponding to the sheet).

The combination of Hoppe and Meunier does not teach or suggest all the limitations of Claims 1 and 32. Claims 1 and 32, therefore, distinguish over the cited references. Claims 2-5, 31 and 33-40 also distinguish over Hoppe and Meunier due to their dependence on Claims 1 and 32, respectively.

Respectfully submitted,

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